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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,291	10/17/2003	Dirk Inze	1187-2 DIV	2625

7590 05/04/2006

Ann R. Pokalsky, Esq.  
DILWORTH & BARRESE, LLP  
333 Earle Ovington Blvd.  
Uniondale, NY 11553

EXAMINER

COLLINS, CYNTHIA E

ART UNIT PAPER NUMBER

1638

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/688,291

**Applicant(s)**

INZE ET AL.

**Examiner**

Cynthia Collins

**Art Unit**

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 and 43-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-40 and 43-49 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION*****Election/Restrictions***

Applicant is reminded that nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. Amino acid sequences of different proteins are also structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide or amino acid sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

Upon election of any of the Groups I and III-X below, Applicant is additionally required to elect a single SEQ ID NO for the elected Group. This requirement is not to be construed as a requirement for an election of species, since each nucleotide and amino acid sequence is not a member of a single genus of invention, but constitutes an independent and patentably distinct invention.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 4-9, 13-23 and 43-44, drawn to a DNA sequence encoding a cyclin-dependent kinase inhibitor, a host cell, a method for the production of transgenic plants, a transgenic plant cell, a transgenic plant or plant tissue, and harvestable parts or propagation material, classified in class 800, subclass 298, for example.  
(If this group is elected, select also a single SEQ ID NO)

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- II. Claims 2-3, drawn to a method for identifying and obtaining a cyclin-dependent kinase inhibitor, classified in class 435, subclass 471, for example.
- III. Claim 10, drawn to a method for the production of a cyclin-dependent kinase inhibitor, classified in class 435, subclass 69.1, for example. (If this group is elected, select also a single SEQ ID NO)
- IV. Claim 11, drawn to a cyclin-dependent kinase inhibitor, classified in class 530, subclass 370, for example. (If this group is elected, select also a single SEQ ID NO)
- V. Claim 12, drawn to an antibody that specifically recognizes a cyclin-dependent kinase inhibitor, classified in class 530, subclass 387.1, for example. (If this group is elected, select also a single SEQ ID NO)
- VI. Claims 24-35 and 45-49, drawn to a regulatory sequence, a recombinant DNA molecule, a vector, a cell, a method for the production of transgenic plants, a transgenic plant cell, a transgenic plant or plant tissue, and harvestable parts or propagation material, classified in class 536, subclass 24.1, for example. (If this group is elected, select also a single SEQ ID NO)
- VII. Claims 36 and 39, drawn to a method for the identification of an activator or inhibitor of genes encoding cyclin-dependent kinase inhibitors, and to a compound which is an activator or inhibitor of cyclin-dependent kinase inhibitors, classified in class 800, subclass 278, for example. (If this group is elected, select also a single SEQ ID NO)

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- VIII. Claim 37, drawn to a method for identifying and obtaining an activator or inhibitor of cyclin-dependent kinase inhibitors, classified in class 435, subclass 4, for example. (If this group is elected, select also a single SEQ ID NO)
- IX. Claim 38, drawn to a method of producing a plant herbicide, classified in class 504, subclass 116.1, for example. (If this group is elected, select also a single SEQ ID NO)
- X. Claim 40, drawn to a diagnostic composition, classified in class 536, subclass 23.6, for example. (If this group is elected, select also a single SEQ ID NO)

The inventions are distinct, each from the other because of the following reasons:

Invention I and Inventions II and IV-X are distinct inventions. The method of Group I utilizes different materials and method steps than are used to practice the methods of Groups II-III and VI-IX. The method of Group I does not require the use of, or result in the production of, the cyclin-dependent kinase inhibitor of Group IV, the antibody of Group V, the regulatory sequence, recombinant DNA molecule, vector, cell, transgenic plant cell, transgenic plant or plant tissue, and harvestable parts or propagation material of Group VI, the compound which is an activator or inhibitor of cyclin-dependent kinase inhibitors of Group VII or the diagnostic composition of Group X. The DNA sequence encoding a cyclin-dependent kinase inhibitor, host cell, transgenic plant cell, transgenic plant or plant tissue, and harvestable parts or propagation material differ in composition from the cyclin-dependent kinase inhibitor of Group IV, the antibody of Group V, the regulatory sequence, recombinant DNA molecule, vector, cell, transgenic plant cell, transgenic plant or plant tissue, and harvestable parts or propagation

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material of Group VI, the compound which is an activator or inhibitor of cyclin-dependent kinase inhibitors of Group VII and the diagnostic composition of Group X.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the host cell can be used in a materially different process of using that product, such as a process of producing the vector DNA.

Invention II and Inventions III and V-X are distinct inventions. The method of Group II utilizes different materials and method steps than are used to practice the methods of Groups III and VI-IX. The method of Group II does not require the use of, or result in the production of, the antibody of Group V, the regulatory sequence, recombinant DNA molecule, vector, cell, transgenic plant cell, transgenic plant or plant tissue, and harvestable parts or propagation material of Group VI, the compound which is an activator or inhibitor of cyclin-dependent kinase inhibitors of Group VII or the diagnostic composition of Group X.

Inventions II and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the cyclin-dependent kinase inhibitor can be made by another and materially different process, such as the method of Group III, or by purification from its native source.

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Invention III and Inventions V-X are distinct inventions. The method of Group III utilizes different materials and method steps than are used to practice the methods of Groups VI-IX. The method of Group III does not require the use of, or result in the production of, the antibody of Group V, the regulatory sequence, recombinant DNA molecule, vector, cell, transgenic plant cell, transgenic plant or plant tissue, and harvestable parts or propagation material of Group VI, the compound which is an activator or inhibitor of cyclin-dependent kinase inhibitors of Group VII or the diagnostic composition of Group X.

Inventions III and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the cyclin-dependent kinase inhibitor can be made by another and materially different process, such as the method of Group II, or by purification from its native source.

Invention IV and Inventions VI-VII and IX-X are distinct inventions. The cyclin-dependent kinase inhibitor of Group IV differs in composition from the antibody of Group V, the regulatory sequence, recombinant DNA molecule, vector, cell, transgenic plant cell, transgenic plant or plant tissue, and harvestable parts or propagation material of Group VI, the compound which is an activator or inhibitor of cyclin-dependent kinase inhibitors of Group VII and the diagnostic composition of Group X. The cyclin-dependent kinase inhibitor of Group IV is not required to practice or produced by the methods of Groups VI-VII and IX.

Inventions IV and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the

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product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the cyclin-dependent kinase inhibitor can be used in a materially different process of using that product, such as in an immunoassay or as an immunogen.

Invention V and Inventions VI-X are distinct inventions. The antibody of Group V differs in composition from the regulatory sequence, recombinant DNA molecule, vector, cell, transgenic plant cell, transgenic plant or plant tissue, and harvestable parts or propagation material of Group VI, the compound which is an activator or inhibitor of cyclin-dependent kinase inhibitors of Group VII and the diagnostic composition of Group X. The antibody of Group V is not required to practice or produced by the methods of Groups VI-IX.

Invention VI and Inventions VII-X are distinct inventions. The method of Group VI utilizes different materials and method steps than are used to practice the methods of Groups VII-IX. The method of Group VI does not require the use of, or result in the production of, the compound which is an activator or inhibitor of cyclin-dependent kinase inhibitors of Group VII or the diagnostic composition of Group X. The regulatory sequence, recombinant DNA molecule, vector, cell, transgenic plant cell, transgenic plant or plant tissue, and harvestable parts or propagation material of Group VI differ in composition from the compound which is an activator or inhibitor of cyclin-dependent kinase inhibitors of Group VII and the diagnostic composition of Group X.

Invention VII and Inventions VIII-X are distinct inventions. The method of Group VII utilizes different materials and method steps than are used to practice the methods of Groups VIII and IX. The method of Group VII does not require the use of, or result in the production of,



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the diagnostic composition of Group X. The compound which is an activator or inhibitor of cyclin-dependent kinase inhibitors of Group VII differs in composition from the diagnostic composition of Group X.

Invention VIII and Inventions IX-X are distinct inventions. The method of Group VIII utilizes different materials and method steps than are used to practice the method of Group IX. The method of Group VIII does not require the use of, or result in the production of, the diagnostic composition of Group X.

Invention IX and Invention X are distinct inventions. The method of Group IX does not require the use of, or result in the production of, the diagnostic composition of Group X.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

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In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and

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specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Remarks***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (571) 272-0794. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

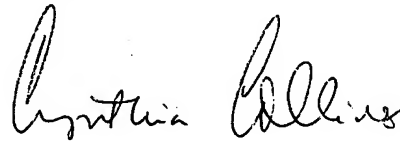
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cynthia Collins  
Primary Examiner  
Art Unit 1638

CC

  
4/20/06